

REMARKS

I. Status of the Claims

Claims 1-50 were filed with the application. Claims 10, 12 and 21-50 have previously been canceled. Claims 1-9, 11 and 13-20 are pending and stand rejected under 35 U.S.C. §112, first paragraph, 35 U.S.C. §102 and/or 35 U.S.C. §103. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

II. Rejection Under 35 U.S.C. §112, First Paragraph

Claims 2-6 are rejected under the first paragraph of §112 as lacking enablement. The examiner acknowledges that the specification is enabling for "inhibiting infection of a cell in a patient or a patient having an existing viral infection." Applicants agree, and have amended the claims to reflect this subject matter. In fact, these scenarios cover preventing *initial* infection of a subject, *i.e.*, where no *active* infection is currently ongoing in the patient. Therefore, it is believed that the rejection is overcome.

II. Rejections Under 35 U.S.C. § 102

Claims 1-9 and 13-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Baldini *et al.* (Baldini), claims 1-9 and 13 stand rejected as anticipated under 35 U.S.C. §102(a) by Aboulafia *et al.* (Aboulafia), and Claims 1-9 and 13-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Murillas *et al.* (Murrillas). Applicants traverse, but the claims have been amended to recite that the treated virus does not include HIV. Reconsideration and withdrawal of the rejection is respectfully requested.

III. Rejections Under 35 U.S.C. §103

Claims 11 and 17-20 stand rejected over Maziere *et al.* and Murillas or Baldini in view of Graham *et al.* and Mills. Maziere is said to teach the inhibition of HIV-1 by lovastatin *in vitro*, and Murillas and Baldini are cited as above. Graham is cited as teaching that HIV and RSV “share a common cellular entry mechanism ... [and that] RhoA peptides inhibit viral entry for other viruses which are demonstrated to share the cellular entry mechanism common to RSV and HIV.” Mills is cited for the teaching of ribavarin as an anti-viral. According to the examiner, the common entry pathway of HIV and RSV would instruct the skilled artisan to use an HMG-Co reductase inhibitor to treat RSV as HIV. Appellants respectfully traverse.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Manual of Patent Examining Procedure* §2142. See also *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed Cir. 1991) (emphasizing that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on appellant’s disclosure). It is important to note that all three elements must be shown to establish a *prima facie* case of obviousness. Thus, if even one element is missing, a *prima facie* case of obviousness does not exist.

Attached to this response is an inventors’ declaration under 37 C.F.R. §1.131, establishing a date of invention prior to the date of the Graham *et al.* reference. As such, that

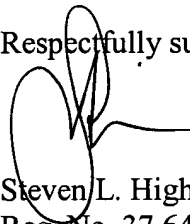
reference is no longer available as art against the claims of this application. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

IV. Conclusion

It is respectfully submitted, in light of the above, that all of the pending claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the examiner have any questions regarding this response, a telephone call to the undersigned is invited.

Please date stamp and return the enclosed postcard to evidence receipt of this document.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven L. Highlander". The signature is stylized with a large, looped initial "S" and a trailing flourish.

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Date: June 17, 2005